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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,108	12/12/2003	Tomohiro Matsuda	CFA00023US	1918
34904 7590 07/23/2009 CANON U.S.A. INC. INTELLECTUAL PROPERTY DIVISION 15975 ALTON PARKWAY IRVINE, CA 92618-3731				
EXAMINER				
JOHNS, CHRISTOPHER C				
ART UNIT		PAPER NUMBER		
3621				
MAIL DATE		DELIVERY MODE		
07/23/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/735,108

**Applicant(s)**

MATSUDA ET AL.

**Examiner**

Christopher C. Johns

**Art Unit**

3621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22, 27, 29, 32, 37 and 39-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22, 27, 29, 32, 37 and 39-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. This Office Action is given Paper No. 20090715 for reference purposes only.
2. This Office Action is in response to the Response to Non-Final Office Action, filed 14 April 2009.
3. All references to the capitalized version of "Applicant" refer specifically to the Applicant or Applicants of record in the instant application. Any references to lowercase versions of "applicant" or "applicants" refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.
4. Claims 22, 27, 29-32, 37, and 39-42 are pending.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22, 30-32, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent 5,974,150 ("Kaish"), in view of Microsoft Computer Dictionary, further in view of Official Notice.

7. As per claims 22, 32, and 42, Kaish discloses:
8. database programmed to store registered trademark image information (figure 1, reference 5) and genuine-product-specific information corresponding to the product name (figure 1, reference 3, 4);
9. input unit configured that inputs product data acquired by scanning a product (figure 2, reference 35-39, 41);
10. determining unit configured that determines that the product is a genuine product when the determining unit determines that the product data input by the input unit includes the registered trademark information and the genuine-product-specific information in the database corresponding to the product name input in the input screen (column 9, lines 12-22; column 10, line 57 - column 11, line 2 - "unique, random, or quasi-unique characteristic of the item is encoded on the label"; column 27, lines 20-30 - "sheet of material...code number...manufacturing information, such as serial number, date, location, lot number, copyright notice");
11. determines that the product is a counterfeit product when the determining unit determines that the product data input by the input unit includes the registered trademark image information in the database corresponding to the product name input in the input screen (column 27, lines 20-30 - "fiber pattern, which is random (irregular), is illuminated..."; column 28, lines 7-30 - "medium is then scanned, and an analogous vector mapping derived from the newly scanned image. The recorded vector map is compared with the measured vector map...");
12. Kaish does not explicitly disclose:
13. providing unit configured that provides an input screen for inputting a product name;

14. Microsoft teaches:

15. providing unit configured that provides an input screen for inputting a product name (Page 524, "touch screen...designed or modified to recognize the location of a touch on its surface").

16. Kaish, in column 17, lines 11-15, recites "manually or automatically verifies the printed code on the label". One such method of "automatically" verifying the printed code on the label is through Optical Character Recognition ("OCR")<sup>1</sup>. One alternative to scanning data is to manually type the text data printed on the paper, using such items as a keyboard or a "touch screen" (defined by Microsoft as a "computer screen designed or modified to recognize the location of a touch on its surface" (page 524), enabling a human user to enter data as he would on a keyboard or any other device).

17. The sole difference between the reference and the instant application is that the reference does not disclose entering data manually using a touch screen, in place of scanning the data using a scanner. Since each individual system of entering data into a computer and its function are shown in the prior art (though in different references), the difference between the claimed subject matter and the prior art rests not on an individual element or function, but the combination itself – that is, in the substitution of a touch screen in Kaish. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a touch screen in place of scanning the product information, because the simple substitution of one known element for another, producing a predictable result, renders the claim obvious. A person having ordinary

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<sup>1</sup> Microsoft discloses that OCR operates by "[examining] printed characters on paper and [determining] their shapes by detecting patters of dark and light" (page 379).

skill in the art would see the substitution as advantageous, because it would allow for a backup method of entering important data.

18. Neither Kaish nor Microsoft explicitly disclose:

19. determine that the product is a third party product when the determining unit determines that the product data input by the input unit does not include the registered trademark image information in the database corresponding to the product name input in the input screen; or

20. a notification unit programmed to notify that the product is not a counterfeit product when the product is determined to be a genuine product or a third party product by the determining unit and to notify that the product is a counterfeit product when the product is determined to be a counterfeit product by the determining unit.

21. The Examiner takes Official Notice that it is old and well-known in the art that human beings would not confuse two separate products (i.e. separate meaning from completely different distributors/manufacturers) as this is the basis of commercial transactions. A human being would not look at a Samsung product and confuse it for a Canon product; as such, if the human were looking at a Canon product, he would not look for identifying marks which are only present on a Samsung product (e.g. a holographic sticker which says "Samsung" or the like).

22. Additionally, were the human being looking for Canon parts alone, he would not report a Samsung product as a "counterfeit"; he would merely note that it is not a Canon product and move on to the next item. (This reasoning is analogous to the idea of digital certificates, whereby a unit of data, such as a program, is inspected for a digital signature. If it contains a digital signature, the signature is checked - if the signature is valid, then the program really is

from who it purports to be from. If it contains a falsified digital signature, then the program is not who it purports to be from. If it does not contain a digital signature, then the program is written off as unidentifiable - as being from a "third party".)

23. Given the advances in fields such as Optical Character Recognition (OCR), it would have been obvious to a person having ordinary skill in the art to provide an automatic mechanism for performing these same tasks. See MPEP §2144.04(III) and *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958): "broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art".

24. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Kaish a step of identifying a product as a third party product when the product is not preliminarily identified as a first-party product; it would also have been obvious to a person having ordinary skill in the art to include in Kaish a unit to notify that such products are not counterfeit, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately.

A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a faster system of identifying products - by not looking for marks which cannot possibly be on a device, time is saved.

25. As per claims 30 and 40, Kaish discloses:

26. product includes toner for a printer (the Examiner contends that this is an intended use of the invention, as such, it is not given patentable weight. Furthermore, there is nothing preventing the system in Kaish from being used as a printer toner counterfeit detection system, instead noting that “electronics and software products are also particular targets of counterfeiters” (column 1, lines 53-56)).

27. As per claims 31 and 41, Kaish discloses:

28. storing determination result (figure 2, reference numbers 20, 24; figure 3, reference numbers 45, 48, 55; figure 4a, reference numbers 106, 107).

29. Claims 27, 29, 37, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaish in view of Microsoft, further in view of Admitted Prior Art.

30. As claims 27-30 and 37-40 are best understood by the Examiner, Kaish teaches:

31. information is written in a micro-character; see Figure 1, reference numbers 8, 10.

32. Kaish does not explicitly disclose using a micro-character to further the security of the system. It is now Admitted Prior Art (under MPEP §2144.03(c)) that using micro-characters for providing a higher lever of visual security was well known to those skilled in the art at the time of the invention. These characters were well known to those skilled in the art at the time of the invention to provide an easily-authenticated system of physical objects. Due to the desire to easily authenticate items using micro-characters being well known to those skilled in the art at the time of the invention, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use micro-characters in conjunction with the system in Kaish, to



give a higher degree of security. A person having ordinary skill in the art would understand that the usage of micro-characters would be advantageous, since it provides for a more easily-authenticated system that is harder to forge;

33. programmed to notify another terminal of a determination result obtained by the determining unit; see column 25, lines 42-49.

34. Kaish does not explicitly disclose that the user information is transmitted to the remote site. There is a desire in the system in Kaish to provide a secure method of authenticating products – evidence exists in column 26, lines 33 – 36. Clearly there is a desire for security, and sending along the authenticated user information would allow for a higher degree of security in the system. It is now Admitted Prior Art (under MPEP §2144.03(c)) that user information is transmitted to the remote site. Additionally, it was obvious to one skilled in the art at the time of the invention to send usernames with secure communication, in order to authenticate transactions. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to send the user information to the remote site, in order to provide a higher level of security. A person having ordinary skill in the art would understand this to be advantageous, as it provides more security;

35. when the unit determines that a product is a counterfeit product, the unit notifies a counterfeit product's regulatory authority terminal of the determination result;

36. Kaish does not explicitly teach that a regulatory authority terminal receives notification of the determination result. It is now Admitted Prior Art (under MPEP §2144.03(c)) that notifying a regulatory authority of counterfeit products was old and well-known in the art because this is how most regulatory authorities receive information on such products, by self-

reporting of individuals receiving counterfeit items. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kaish to send information to a regulatory authority of the counterfeit nature of the scanned product, because it would enable a more informative and helpful (in stemming the problem of counterfeiting) system, something that a person having ordinary skill in the art would see as advantageous.

### *Response to Arguments*

37. Applicants' arguments with respect to the claims have been considered but are moot in view of the new ground of rejection. They argue limitations that were not previously in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

### *Conclusion*

38. Applicants' amendment of 14 April 2009 necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

39. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

41. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

42. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/  
Examiner, Art Unit 3621

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621